

REMARKS

1. Summary of the Office Action

In the non-final Office Action mailed September 25, 2008, the Examiner rejected claims 1-36 under 35 U.S.C. § 112, ¶ 1 as failing to comply with the written description requirement. The Examiner rejected claims 1-14, 31, 32, and 35 under 35 U.S.C. § 101 as directed toward non-statutory subject matter.

2. Status of the Claims

Claims 1-48 are currently pending in this application. Of these, claims 1 and 15 are independent and the remainder are dependent. In this response, Applicant has amended claims 1-2, 4, 6-15, 19, 21, 31-32, and 35 to further clarify the claimed subject matter. Further, Applicants have added new claims 37-48 in this response that recite similar limitations to those recited in corresponding claims 16-27. These amendments are generally supported by the specification.

3. Response to Claim Rejections

a. Response to 35 U.S.C. § 112, ¶ 1 Rejections

In the non-final Office Action mailed September 25, 2008, the Examiner rejected claims 1-36 under 35 U.S.C. § 112, ¶ 1 as failing to comply with the written description requirement, and specifically indicating that the limitation of “regardless of whether the script tags and operable program code are associated with a known virus” recited in claims 1 and 15 was not in the specification. Applicant has amended claims 1 and 15 to remove recitation of removal of script tags, although it is submitted that a person skilled in the art would understand that if the

operable program code is removed it is desirable that the script tags which refer to, or call, the operable code are also removed.

Applicant respectfully draws the Examiner's attention to the passage of the specification at page 1 lines 14-27 and page 2 lines 1-2 (as amended March 16, 2001) from which it is clear that the present invention is directed to the insufficiency in the background art that in the background art only known viruses can be detected and removed. Applicant also draws the Examiner's attention to the passage of the specification on page 5 lines 20-27 (as amended March 16, 2001) where it is stated that, "the present invention does not seek to determine whether program coding included with an electronic message is malicious" [e.g., is a known virus] "or not, but removes the capability of such an electronic message to execute the program or commands."

In addition, Applicant requests the Examiner review the paragraph on page 6, line 22 – page 7, line 27 discussing the removal of script tags which discloses, *inter alia*, "**[i]f a script tag is found in an embodiment or attachment, the program is removed, step 105, from the body or attachment...**The intended recipient, therefore, receives a cleaned electronic mail message, which has no capability of running any programs and is, therefore, completely secure." Specification, p. 7, lines 15-17 and 24-26 (emphasis added). Thus, the specification clearly indicates (i) that a program is removed once script tags are found and (ii) does not limit that removal to being associated with a virus.

Further, in a similar discussion about macros, Applicant respectfully requests the Examiner review page 8, lines 12-17 of the specification which disclose:

In this manner, the method of the invention automatically removes any attachments form an electronic mail message which have the capability of running program codes or external programs by using macros. That is, **all macros or**

attachments are removed and deleted, or at least quarantined, whether they are harmful or not.

(emphasis added).

Applicant therefore respectfully requests the Examiner withdraw the rejections of claims 1-36 under 35 U.S.C. § 112, ¶ 2.

b. Response to 35 U.S.C. § 101 Rejections

The Examiner rejected claims 1-14, 31, 32, and 35 as being directed toward non-statutory subject matter. Specifically, the Examiner asserted “that the subject matter recites detecting, analysis, and application means understood by the examiner in view of the specification to be implemented through software...and therefore the recited claims are directed to functional descriptive material. Generally functional descriptive material (i.e., software) is statutory when it is stored on a tangible computer readable storage medium.” Office Action, p. 3.

We submit that there is no limitation in the application as filed for the invention to be implemented through software and a person skilled in the art would understand that the invention can desirably be performed by, for example, hardware or firmware. However, solely to expedite prosecution, Applicant has amended claim 1 to recite, *inter alia*, “An anti-virus system for an electronic mail message, the system comprising a computer comprising a computer-readable medium storing:...”

Support for this amendment may be found generally throughout the specification and specifically on at least page 5, lines 11-15 and page 6, lines 21-25 (gateways and electronic mail servers generally being considered to be computers to those skilled in the art). As the Examiner indicated in the Office Action, functional descriptive material is statutory when it is stored on a

tangible computer readable storage medium, such as the computer-readable medium of the computer recited in amended claim 1. *See* Office Action, p. 3.

With these amendments, Applicant submits that each of the 35 U.S.C § 101 rejections have been traversed and therefore respectfully requests the Examiner withdraw the 35 U.S.C. § 101 rejections.

4. Conclusion

There may be other reasons for patentability for the claims, and Applicant does not waive those arguments by failing to assert them here. Applicant views the foregoing reasons as sufficient to establish that the claims are not anticipated or *prima facie* obvious. Applicant expressly reserves the right to make further arguments regarding patentability of the claims in future proceedings.

In view of the foregoing, Applicant submits that all of the pending claims are allowable. Therefore, Applicant respectfully requests favorable reconsideration and allowance of all of the claims. Should the Examiner wish to discuss the case with the undersigned, the Examiner is invited to call the undersigned at (312) 913-3338.

Respectfully submitted,

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